

REMARKS

Claims 1-27 are pending. Applicant respectfully traverses the grounds for Examiner's rejections listed below.

I. Information Disclosure Statement

Examiner noted that an information disclosure statement filed on August 21, 2003 failed to comply with 37 C.F.R. 1.98(a)(2) due to the fact that an English translation was not provided for EP 0 550 342. United States Patent No. 5,312,451 to Limousin, a United States counterpart to the cited European patent which was disclosed in that same August 21, 2003 information disclosure statement, is an accurate English translation of the European patent disclosure.

II. Claim rejections under 35 U.S.C. § 112

Claims 1-13 were rejected as being indefinite. Independent claim 1 has been amended to include "means for suspecting a loss of an atrial detection or capture" to clarify that both loss of atrial detection or atrial capture may be suspected. Applicant believes that this addresses Examiner's concerns over the condition recited in lines 10-12 of claim 1 and respectfully asks that the Examiner withdraw the grounds for this rejection.

III. Claim rejections under Double Patenting

Claims 1, 2, 4, 5, 8-15, 17, 18, 21, 22, 24, and 25 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting. In response, Applicant has filed a terminal disclaimer which is enclosed with this response. Thus, Applicant respectfully asks that the Examiner withdraw the grounds for this rejection.

IV. Claim rejections under 35 U.S.C. § 102

Claims 1-3 were rejected under 35 U.S.C. § 102(b) as being anticipated by Sun (U.S.

PATENT

Attorney Docket No. 8707-2161
163B – Gestion Capteur
Customer No.: 34313
Confirmation No.: 7566

Patent No. 6,129,745) and claim 14 was rejected under 35 U.S.C. § 102(b) as being anticipated by Hill (U.S. Patent No. 6,195,584). Applicant respectfully traverses the ground for these rejections.

“[A] claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference.” *Celeritas Techs., Ltd. v. Rockwell Int’l. Corp.*, 150 F.3d 1354, 1361, 47 U.S.P.Q.2d 1516, 1522 (Fed. Cir. 1998). The standard for lack of novelty, that is, for “anticipation,” is one of strict identity. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1296, 63 U.S.P.Q.2d 1597, 1600 (Fed. Cir. 2002). Independent claims 1 and 14 were amended to include a “means for automatic mode commutation” and the additional limitation that said conditions are detected “in order to prevent inappropriate switching to a DDD pacing mode.” Neither Sun nor Hill disclose any means for automatic mode commutation whereby such conditions are detected in order to prevent inappropriate switching to a DDD pacing mode. For this reason, Applicant respectfully asks that the Examiner withdraw the grounds for these rejections.

V. 35 U.S.C. § 103(a) Rejections

Claim 8, which is dependent to independent claim 1 through claim 2, was rejected under 35 U.S.C. § 13(a) as being unpatentable over Sun in view of Hill. Applicant respectfully traverses the grounds for this rejection in view of the above amendments to the claims and the following remarks.

To establish a *Prima Facie* case of obviousness, there must be: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine references teachings; (2) a

PATENT

Attorney Docket No. 8707-2161
163B – Gestion Capteur
Customer No.: 34313
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reasonable expectation of success; and (3) prior art references which teach or suggest all of the claim limitations. *See In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000); MPEP § 2143 (8th Ed., Rev. 1).

In the present invention, independent claim 1 has been amended to include a "means for automatic mode commutation" and the additional limitation that said conditions are detected "in order to prevent inappropriate switching to a DDD pacing mode." As discussed above, neither Sun nor Hill disclose any means for automatic mode commutation whereby such conditions are detected in order to prevent inappropriate switching to a DDD pacing mode. For this reason, Sun and Hill, when viewed in combination or alone, fails to teach or suggest all of the claim limitations in claims at issue in the present application.

Additionally, neither the Sun nor Hill reference would motivate one to modify either reference to include the "means for automatic mode commutation" and the additional limitation that said conditions are detected "in order to prevent inappropriate switching to a DDD pacing mode" as claimed in the present invention. Instead, both Sun and Hill disclose methods directed towards an entirely different function. Sun discloses a method a detection means for loss of atrial detection responsive to atrial lead dislodgement and Hill discloses teachings for a means to diagnose atrial undersensing. Neither would motivate one of ordinary skill in the art to modify either reference to include the limitation noted above.

For the foregoing reasons, Applicant believes Claim 8 is now in condition for allowance.

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Attorney Docket No. 8707-2161
163B – Gestion Capteur
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CONCLUSION

Reconsideration of this application in view of the foregoing remarks respectfully is requested.

The Examiner is invited to call Applicant's undersigned attorney if doing so would expedite prosecution.

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Respectfully submitted,



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